

No. 21160

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

CERAMIC TILERS SUPPLY, INC., a corporation,

Appellant,

vs.

TILE COUNCIL OF AMERICA, INC., a corporation,

Appellee.

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

Appellant, Ceramic Tilers Supply, Inc., hereby petitions for a rehearing to reconsider the judgment entered in this action on May 22, 1967, on the following grounds.

1. Limestone Is Generic to Chalk; Therefore, by Definition, Functional Difference Is Not Possible.

The principal question in the present posture of the case is whether a patented recipe is anticipated by a prior recipe in which "pulverized chalk whiting" is specified as an ingredient rather than the claim-specified: "powdered limestone" (*not granular*). The prior formula is distinguished, essentially only by this difference, and the Court found an apparent functional difference between the "limestone" and "chalk ingredients."

Testimony of Appellee's expert, Dr. Lacy, is directly to the contrary:

“Q. Now as I understand it, chalk is also a form of calcium carbonate or limestone, is that correct? A. Yes. It is a form of calcium carbonate.

Q. In reading the claims and in considering their description of various ingredients here, which we have also considered in other instances, I understand that you certainly considered somewhat as equivalent *calcium carbonate* and *limestone* and *sand* wherever those ingredients were specified, is that true? A. *Functionally I think they would be all the same.*” [RT 289:6-15] (emphasis added.)

It is further respectfully submitted that the applicable law of this Court, the trial record of the case, and facts of judicial notice conclusively and irrefutably establish that “*pulverized chalk whiting*” is one form or species of “*powdered limestone*.” The word “limestone” includes “chalk” by definition, therefore functional differences between the two cannot exist.

The following premises, each above reproach, here presented without argument, establish the asserted patent to be invalid.

ISSUE:

(a) The basis of distinguishing the patent from the prior art (Opinion P3) is that the ingredient recited in the patent's claims as “*powdered limestone*” differs from “*pulverized chalk whiting*” as recited in the prior recipe. (See U. S. Patent 2,934,932 and Ex. J, Spillman.)

LAW:

(b) The words “*powdered limestone*” are not explained in the patent; therefore, they must be given their ordinary meaning (see *U. S. Patent*

2,934,932; *Chemical Construction Corporation v. Jones & Laughlin Steel Corp.* (3rd Cir. 1962), 311 F. 2d 367, 136 U.S.P.Q. 150. *Universal Oil Products Co. v. Globe Oil & Refining Company*, 137 F. 2d 3, 58 U.S.P.Q. 504 (7th Cir. 1943) Affd. 322 U.S. 471, 61 U.S.P.Q. 382).

FACT:

(c) By ordinary meaning, the words “*powdered limestone*” concisely and clearly define *any* of a class of calcium carbonate minerals reduced to a finely-divided state. That definition clearly includes “*pulverized chalk whiting*,” by universal definition.

LIMESTONE:

“sedimentary rock wholly or in large part composed of calcium carbonate. It is ordinarily white but may be colored by impurities, iron oxide making it brown, yellow or red and carbon making it blue, black or grey. The texture varies from coarse to fine. . . . Among the important varieties of limestone are, MARL, CHALK, OOLITE, TRAVERTINE, DOLOMITE, and MARBLE.” *The Columbia Encyclopedia* (1959).

(See other authorities set out in the appendix at length.)

LAW:

(d) As the patent broadly claims all those pulverized rocks defined as “*powdered limestone*,” it may not be limited at this time to exclude one specific rock in the group. Excessively-broad claims cannot be saved by distorting the meaning of their words. *Beatty Scaffold Company v. Up-Right, Inc.* (9th Cir. 1962), 306 F. 2d 626, 134 U.S.P.Q. 379; also *Del Francia v. Stanthony Corp.* (9th Cir. 1960), 125 U.S.P.Q. 382.

LAW:

(e) As the broad term “powdered limestone” defines a group of pulverized rocks that include “pulverized chalk whiting”, the reference formula would unquestionably *infringe the claims of the patent*. That which would infringe if later, invalidates if earlier. That is, the prior formula (essentially identical to the patented formula but for the recitation of *chalk* rather than *limestone*) would clearly fall within the scope of the patent claims. As an unavoidable consequence, the patent is *invalid*. *Becker v. Webcor, Inc.* (7th Cir. 1961), 129 U.S.P.Q. 111; *Chemical Construction Corporation v. Jones & Laughlin Steel Corp.* (3rd Cir. 1962), 311 F. 2d 367, 136 U.S.-P.Q. 150; *In re Slater*, 276 F. 2d 408, 125 U.S.P.Q. 345 (C.C.P.A., 1960); also *Smith-Blair, Inc. v. Dresser Industries, Inc.* (D.C. N. Calif.), 131 U.S.P.Q. 305.

The logic set forth above is supported in the record and does not conflict with actual testimony taken during trial, nor, is there substantial legal authority to the contrary. (See sections 2 and 3 of the Appendix relative to finely-divided fibrous material and testimony of appellant’s president.)

2. A Determination That the Cellulose Gums Are Equivalent for Infringement Purposes, Necessitates Their Equivalence for Validity Purposes.

Succinctly, if the cellulose gums in the recipes are equivalent for determining infringement, they are also equivalent *for determining validity*. *Air Devices, Inc. v. Air Factors, Inc. et al.* (9th Cir. 1954), 210 F. 2d 481, 100 U.S.P.Q. 296; *Moon v. Cabot Shops, Inc., et al.* (9th Cir. 1959), 270 F. 2d 539, 123 U.S.P.Q. 60;

Nelson v. Batson (9th Cir. 1963), 322 F. 2d 132, 138 U.S.P.Q. 522. As an unavoidable consequence, of finding equivalence, for infringement purposes, United States Patent 2,934,932 is invalid on the basis of the recipe disclosed in the Kaveler patent, Ex. P. A recognized expert in the field of cellulostics, Dr. Stone, testified conclusively and without challenge, that the cellulose gum employed in the accused mortar mixes is identical to that described in the prior-art reference Ex. P. [Tr. 793].

Dated: June 20, 1967.

BYARD G. NILSSON,
Attorney for Ceramic Tilers Supply, Inc.

Undersigned Counsel certifies that this petition is not interposed for delay and that in his judgment it is well founded.

BYARD G. NILSSON

APPENDIX.

1. The Ordinary Meaning of the Words, "POWDERED LIMESTONE."

POWDERED: "reduced to a powder; PULVERIZED." *Webster's Third New International Dictionary* (1961).

POWDER: "to become pulverized" *The Random House Dictionary of the English Language* (1966).

LIMESTONE: "any stone consisting wholly or mainly of calcium carbonate." *The Random House Dictionary of the English Language* (1966).

LIMESTONE: "a rock that is chiefly formed by accumulation of organic remains . . . that consists mainly of calcium carbonate. . . ." *Webster's Third New International Dictionary* (1961).

"LIMESTONE, is a common and widely distributed sedimentary rock consisting essentially of calcium carbonate, CaCO_3 , but varying greatly in composition, color and texture. Most limestones are of organic origin and represent the calcareous remains of animal and plant organisms usually inhabiting salt water. . . .

. . . "CHALK, a type of limestone, is composed of the microscopic skeletons of foraminifera." *The Encyclopedia Americana*, Vol. 17 (1967).

WHITING: "pure-white chalk (calcium carbonate) which has been ground and washed. . . ." *The Random House Dictionary of the English Language* (1966).

ROCKS—"Any solid mineral substance, of whatever character, naturally deposited, forming part of the surface or crust of the earth; From a geological point of view granite, *chalk*, gravel, sand, and clay are all rocks."

*The Universal Dictionary of the English Language,
Published by George Routledge & Sons, Ltd. 1932 ED.*

LIMESTONE—All limestones from the softest *chalks* to the hardest marbles consisting essentially of *carbonate of lime*.

*New English Dictionary of Historical Principals, Ox-
ford University Press, Oxford, England.*

2. The Trial Record Does Not Establish Functional Differences Between Chalk and Limestone in the Patented Recipe.

The ingredient “chalk whiting” by common definition is a type of limestone. In addition to serving as an aggregate ingredient, it may be used to “whiten” the recipe mix to which it is added. Because it is select and prepared, it is normally more expensive. Nevertheless, it is undisputably *limestone*. It is sometimes practical to employ both chalk whiting and a cheaper pulverized limestone in a mortar, as for reasons of economy. Yet, in function as an aggregate, both are clearly “*limestone*” as *expressly specified* in the patent claims. Thus, the testimony of appellant’s president [RT 638:6-24 and RT 642:18], appellee’s expert [RT 288] and appellant’s expert [RT 854] all support the ordinary meaning of the words in question. Chalk is a form of limestone! Functionally, the specific is identical to the generic.

3. The Accused Mortars Include Divided Fibrous Materials.

To the point that the Spillman patent [Ex. J] states:

“If desired, further finely divided fibrous materials, such as saw dust, may be added to the filler”
[Ex. J, p. 2]

the asserted patent states:

“Certain other ingredients may be used in the mortars for particular purposes, these being generally used in minor amounts.”

(Patent 2,934,932, column 5, line 71)

In fact, one of the accused mixes (now adjudged to infringe) includes another ingredient. Furthermore, that ingredient is a “*finely divided fibrous material*” just as specified in Spillman [Ex. J]. The ingredient is asbestos. [Pre-trial Conference Order R. 88]

